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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/006,014

12/04/2001

Chen Xing Su

10209.276

6898

21999

7590

06/01/2006

EXAMINER

OH, SIMON J

KIRTON AND MCCONKIE

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ART UNIT

PAPER NUMBER

1618

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicati n N .</b>	<b>Applicant(s)</b>	
	10/006,014	SU ET AL.	
	<b>Examin r</b>	<b>Art Unit</b>	
	Simon J. Oh	1618	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10,12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10,12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Papers Received***

Receipt is acknowledged of the applicant's amendment and response, all received on 20 March 2006.

### ***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claims 1-8 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is maintained.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claims 1-8 under 35 U.S.C. 103(a) as being unpatentable over Gidlund is hereby withdrawn.

The rejection of Claims 9, 10, 12, and 13 under 35 U.S.C. 103(a) as being unpatentable over Gidlund is maintained.

*Response to Arguments*

The applicant's arguments, received on 20 March 2006, have been considered, but are not found to be persuasive.

The examiner considers the property of selective cyclooxygenase-2 inhibition to be implicit and inherent to the disclosure of the prior art. As the art has already shown guidance that the invention of the Gidlund reference is useful for treating various conditions of pain, such as menstrual cramps, arthritis, sprains, and injuries, the examiner considers such a disclosure to be further guidance and evidence towards that rationale. The applicant is reminded that a composition known in the prior art does not become patentable upon the discovery of a new property. See MPEP § 2112. The burden remains on the applicant to show the unobvious difference between the instantly claimed invention and the prior art that would render patentability unto the instantly claimed invention.

The applicant's arguments do not overcome the rejection under 35 U.S.C. 112, because the portions to which the applicant refers for support simply do not exist in the specification, as originally filed. In the specification submitted on 04 December 2001, there are only 10 lines of text on Page 14. There does not even exist a twenty-first line on that page, as referred to by the applicant. The references to the parts of the originally filed specification made by the applicant do not correspond to the applicant's description of those parts set forth in the response filed on 20 March 2006. As such, the rejection under 35 U.S.C. 112 will be maintained.

As stated in the previous Office Action, the applicant has attempted to distinguish the instant claims over the disclosure of the prior art by stating that the a patient having a mass of 70

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kg would be administered 7 mL of liquid extract per day. However, a very simple unit conversion would show that 7 mL is equivalent to less than 0.25 fluid ounces. The applicant has simply decided to ignore this important calculation, since limitations of further dependent claims, such as Claim 2, require the administration of 2 to 3 fluid ounces. This would mean that at the ratio of less than 0.1 mL per kg of body weight of a patient, that patient would have to have a body mass of at least 590 kg, well over half of a metric ton.

It is clear then that the claim limitation of a daily dosage of less than 0.1 mL per kg of body weight of a patient, as introduced into the claims in the amendment of 25 November 2005, is merely nothing more than an unsuccessful attempt to overcome the teachings of the prior art. This claim limitation has no support in the instant specification and directly contradicts the limitations set forth by the dependent claims. For these reasons, the instantly claimed invention remains rejected.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Correspondence*

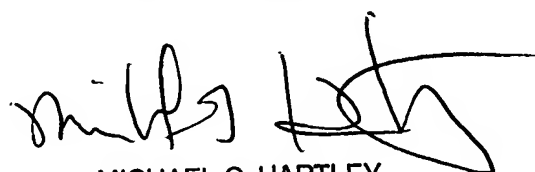
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon J. Oh whose telephone number is (571) 272-0599. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Simon J. Oh  
Examiner  
Art Unit 1618

sj0

  
MICHAEL G. HARTLEY  
SUPERVISORY PATENT EXAMINER